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Patent

Attorney Docket No. 1022702-000304

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|----------------------------|
| In re Patent Application of |) | MAIL STOP AMENDMENT |
| Volker DORING et al. |) | |
| Application No.: 10/560,760 |) | Group Art Unit: 1623 |
| Filing Date: October 6, 2006 |) | Examiner: Jonathan S Lau |
| Title: PRODUCTION OF 2'-DEOXYNUCLEOSIDES AND 2'-DEOXYNUCLEOSIDE PRECURSORS FROM 2-DEHYDRO-3-DEOXY-D-GLUCONATE |) | Confirmation No.: 5121 |

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is enclosed.
- ☐ _____ Terminal Disclaimer(s) and the ☐ \$ 70 ☐ \$ 140 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.
- ☐ Also enclosed is/are: _____
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$ 405 ☐ \$ 810 fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____ on _____ for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

| AMENDED CLAIMS | | | | | |
|--|---------------|---|--------------|-----------------|----------------|
| | No. of Claims | Highest No. of Claims Previously Paid For | Extra Claims | Rate | Additional Fee |
| Total Claims | 0 | 20 | 0 | x \$ 52 (1202) | \$ 0 |
| Independent Claims | 0 | 3 | 0 | x \$ 220 (1201) | 0 |
| <input type="checkbox"/> If Amendment adds multiple dependent claims, add \$ 390 (1203) | | | | | \$ 0 |
| Total Claim Amendment Fee | | | | | \$ 0 |
| <input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee | | | | | 0 |
| TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT | | | | | \$ 0 |

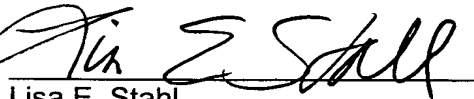
- ☐ Charge _____ to Deposit Account No. 02-4800 for the fee due.
- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to credit card for the fee due. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date January 9, 2009

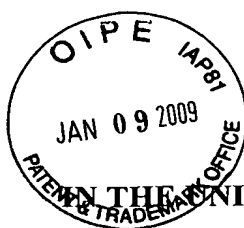
By:



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| In re Patent Application of |) | |
| Volker Doring et al. |) | Group Art Unit: 1623 |
| Application No.: 10/500,760 |) | Examiner: Jonathan S. Lau |
| Filed: October 6, 2006 |) | Confirmation No.: 5121 |
| For: PRODUCTION OF 2'- |) | |
| DEOXYNUCLEOSIDES AND 2'- |) | |
| DEOXYNUCLEOSIDE PRECURSORS |) | |
| FROM 2-DEHYDRO-3-DEOXY-D- |) | |
| GLUCONATE |) | |

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Restriction/Election Requirement ("Action") mailed December 9, 2008, Applicants submit herewith the following response.

The Examiner sets forth a Restriction Requirement at pages 3-6 of the Action. Applicants respectfully traverse the Restriction Requirement as set forth by the Examiner. Moreover, Applicants respectfully assert that Groups I - VIII should properly be examined together. Further, Applicants submit that Groups I - VIII are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of numerous applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by

different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the eight groups are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. *M.P.E.P.* § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the Restriction Requirement are requested.

Nevertheless, Applicants hereby elect, with traverse, Group V (*i.e.*, claims 68-82 and 49-51). Applicants further elect, with traverse, for the purposes of searching only - the species pyruvate decarboxylase.

In making the species election, Applicants understand that the Office will follow the procedure set forth in *M.P.E.P.* § 809.02, which provides for a complete action on the merits of all claims readable on the elected species, and in *M.P.E.P.* § 803.02, whereby on the finding of allowable species, examination will continue with the non-elected species until all species have been examined or a non-allowable species is found.

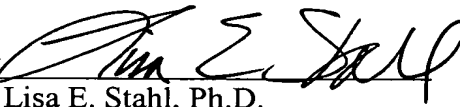
Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Dated: January 9, 2009

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